

REMARKS

In the Office Action dated November 28, 2005, claims 1-26 were presented for examination. The Examiner rejected claims 1-26 under 35 U.S.C. §101, and the Examiner rejected claims 1-26 under 35 U.S.C. §103(a).

The following remarks are provided in support of the pending claims and responsive to the Office Action of November 28, 2005 for the pending application.

I. Rejection of claims 1-26 under 35 U.S.C. §101

Claims 1-26 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. More specifically, claims 1-9 and 25-26 are directed to a method comprising a plurality of steps. Applicant has amended the preamble of both claims 1 and 25 to claims that the method is "computer implemented". Based upon this amendment, as suggested by the Examiner, Applicant respectfully requests that the Examiner remove this rejection of claims 1-9 and 25-26.

With respect to claims 19-24, this grouping of claims is directed to an article with a computer readable medium. These claims had previously had language pertaining to a "signal bearing medium", however, this language was removed from the claim. The Examiner states in the outstanding Office Action that claims 19-24 are directed to a "signal bearing medium" which is allegedly non-statutory subject matter. See page 3, paragraph 6 of the Office Action. Based upon the earlier amendment removing the "signal bearing medium" element from the body of claim 19, Applicant respectfully requests that the Examiner remove this rejection of claims 1-9 and 25-26.

With respect to claim 10-18, this grouping of claims is directed to a computer system, and more specifically a remote administrator and a device driver in communication with the remote administrator. The Examiner states in the outstanding Office Action that claims 10-18 are directed to an intended use statement. However, Applicant has amended claim 10 to positively recite the physical hardware elements in the computer system. Accordingly, Applicant respectfully requests that the Examiner remove this rejection of claims 10-18.

II. Rejection of claims 1-26 under 35 U.S.C. §103(a)

Claims 1-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore et al.* (U.S. Patent Publication No. 2004/0133609) in view of *Logue et al.* (U.S. Patent No. 6,647,421).

Applicant's remarks to the *Moore et al.* publication '609 and the *Logue et al.* patent '421 provided in the response to the prior Office Actions are hereby incorporated by reference.

With respect to claims 1, 10, 19, and 25, the Examiner combines *Moore et al.* with *Logue et al.* to teach all of the elements in the claim. Neither *Moore et al.* nor *Logue et al.* teaches receipt of the message within system firmware. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). There is no teaching, or suggestion to teach the use of "firmware" in either of the *Moore et al.* publication or the *Logue et al.* patent in association with launching to tasks assigned different priorities. "All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP §2143.03, citing, *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In fact, the *Moore et al.* publication employs middleware to provide uniform access to diverse storage devices in a heterogenous computing environment. See *Moore et al.* paragraph 0064. Middleware is software that connects two applications. It is commonly used to connect two sides of an application and passes data between them. In contrast, firmware is software that has been written onto read only memory (ROM). Middleware and firmware are two separate and distinct elements that are not substitutable for one another. Accordingly, there is no teaching or suggestion in either *Moore et al.* or *Logue et al.* for receiving a message from a remote administrator within system firmware.

Furthermore, as noted by the Examiner, *Moore et al.* does not teach or suggest use of an administrator to launch a low priority task as an aspect of spawning a lower priority task from a higher priority task. The Examiner uses *Logue et al.* to support use of an administrator component. However, the administrator of Applicant is not analogous to the administrator of *Logue et al.* "In order to rely on a reference as a basis for rejection of an applicant's invention,

the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP §2141.01, citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The administrator as claimed by Applicant pertains to communicating a message within system firmware associated with launching a lower priority task. The administrator of *Logue et al.* pertains to generating and transmitting a hit report. Although both Applicant and *Logue et al.* use an "administrator", the configuration of their administrators are in different fields and are therefore not equivalent. In fact, it appears that the Examiner is using the term in the language of the claims and citing another computer related invention that uses the same term for a non-analogous purpose. Applicant states in the preamble that the invention relates to "spawning a lower priority task from a higher priority task". *Logue et al.* does not pertain to the claimed subject matter, namely spawning a lower priority task from a higher priority task. The Court of Appeals for the Federal Circuit has long held that "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet that is the very process that the Examiner has undertaken. *Logue et al.* does not show, teach, or suggest implementing their administrator for spawning a lower priority task from a higher priority task. Rather, the administrator of *Logue et al.* appears to be limited to sending a request to a processor for a hit report. Courts have long recognized that most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. The Court of Appeals for the Federal Circuit has stated that:

If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed invention would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'

In re Rouffet, 149 F. 3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (citing *Sensonics, Inc. Aerosonic Corp.*, 81 F.2d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)). In the present

case, as one would naturally expect, the Examiner is finding some of the elements of Applicant's invention in various prior art patents and publications. However, the Examiner goes further in the present case by then using the Applicant's claimed invention as a template to combine the elements found in the prior art in a way neither found in the prior art nor even functional in the prior art. It speaks to the novel nature of Applicant's invention that when Applicant's claimed invention is viewed in its entirety it is greater than the sum of its parts and combines to form an invention that produces an improvement over the prior art systems. Accordingly, the Applicant respectfully contends that the combination of *Moore et al.* in view of *Logue et al.* does not, and can not, meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests the removal of the rejection of claims 1-26.

With respect to the "flag" as noted in claims 5-7, 15-17, 22, 23, and 25, the prior art does not teach use of a flag associated with the task of launching a lower priority task, as noted by the Examiner on page 5, paragraph 14, in the Office Action dated November 28, 2005. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *Moore et al.* does not teach a flag for differentiating and handling request priorities, as claimed by Applicant. "It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . ." *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992). Yet, this is exactly what the Examiner appears to be doing. *Moore et al.* teaches use of a flag for other aspects of their invention, but not for differentiating among requests. If *Moore et al.* had wanted to use a flag for differentiating among tasks, then *Moore et al.* would have done so. The fact that *Moore et al.* does not use a flag for the use claimed by Applicant should serve as evidence that *Moore et al.* does not teach or suggest this claimed limitation. Accordingly, Applicant respectfully requests allowance of claims 5-7, 15-17, 22, 23, and 25.

Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicant requests that the Examiner indicate allowability of claims 1-26, and that the

application pass to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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